

RECEIVED**CENTRAL FAX CENTER****WILLKIE FARR & GALLAGHER LLP****FAX TRANSMISSION****JAN 25 2005**787 Seventh Avenue
New York, NY 10019-6099
(212) 728-8000

Date: January 25, 2004

Time:

Total number of pages (including this page): **64**

Please include Client/Matter No. below

FROM: David E. BoundyRoom No.: 4578
Phone No.: (212) 728-8757
Direct FAX: (212) 728-9757**TO:** Examiner Richard Ellis
Art Unit 2183,
U.S. Patent and Trademark Office

Fax No.: 703 872 9306

Telephone No.: (571) 272-4165

City: Alexandria

State: Virginia

CONCERNING APPLICATION:

Applicant(s): John S. Yates, Jr., et al.

Serial No.: 09/385,394

Art Unit: 2183

Filed: August 30, 1999

Examiner: Richard Ellis

Title: COMPUTER WITH TWO DIFFERENT EXECUTION MODES

AFTER FINAL - EXPEDITED PROCEDURE

I hereby certify that the attached

- This FAX cover sheet
- Request to Withdraw Finality of Office Action
- Response to Office Action
- Change of Correspondence Address
- Information Disclosure Statement and Form PTO-1449
- ~~1 reference~~

along with any paper(s) referred to as being attached or enclosed) are being transmitted by facsimile on January 25, 2004 to Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Dated: January 25, 2004By: David E. Boundy

David E. Boundy

Registration No. 36,461

Confidentiality Note:

The information contained in this facsimile ("fax") transmission is sent by an attorney or his/her agent, is intended to be confidential and for the use of only the individual or entity to which it is addressed. The information may be protected by attorney/client privilege, work product immunity, or other legal rules. If the reader of this message is not the intended recipient or agent responsible for delivering it to the intended recipient, you are hereby notified that any retention, dissemination, disclosure, distribution, copying, or other use of this fax is strictly prohibited. If you have received this fax in error, please notify us immediately by telephone in order to arrange for the destruction of the fax or its return to us at our expense. THANK YOU.

Attention Recipient:

If Any Problems:

Call (212) 728-8911

Receiving Fax Number:

(212) 728-8111

Internal Use Only:

Client No.: 114596-03-4000

Matter No.:

Attorney No.: 12256

Please check here if you want faxed document returned to you *instead of* sent to Records Department.

PATENT

ATTORNEY DOCKET NO. 114596-03-4000

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Serial No.: 09/385,394 Confirmation No.: 9093
Applicant: John S. Yates, Jr., et al.
Title: COMPUTER WITH TWO DIFFERENT EXECUTION MODES
Filed: August 30, 1999
Art Unit: 2183
Examiner: Richard Ellis
Atty. Docket: 114596-03-4000
Customer No. 38492

**RECEIVED
CENTRAL FAX CENTER**

JAN 25 2005

AFTER FINAL - EXPEDITED PROCEDURE**REQUEST FOR WITHDRAWAL OF FINALITY OF OFFICE ACTION**

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Applicant requests that the premature finality of the Action of October 25, 2004 be withdrawn – that is, that prosecution be reopened – and that the Response to Office Action and Information Disclosure Statement filed herewith be entered as of right.

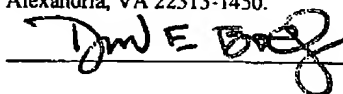
I. Claim 104 has Not Been Examined, and No “Clear Issue” is Developed – It Cannot Be Finally Rejected

37 C.F.R. § 1.113 reads as follows:

37 C.F.R. 1.113. Final rejection or action.

(b) In making such final rejection, the examiner shall repeat or state all grounds of rejection then considered applicable to the claims in the application, clearly stating the reasons in support thereof.

I certify that on January 25, 2004 this correspondence, along with any documents referred to therein, is being transmitted by facsimile to Art Unit 2183 at FAX no. 703 872 9306 and deposited with the United States Postal Service as First Class Mail in an envelope with sufficient postage addressed to Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.



Request for Withdrawal of Finality
This paper dated January 25, 2005

1

114596-03-4000

S/N 09/385,394
2727886.3

PATENT

ATTORNEY DOCKET NO. 114596-03-4000

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Serial No.: 09/385,394 Confirmation No.: 9093
Applicant: John S. Yates, Jr., et al.
Title: COMPUTER WITH TWO DIFFERENT EXECUTION MODES
Filed: August 30, 1999
Art Unit: 2183
Examiner: Richard Ellis
Atty. Docket: 114596-03-4000
Customer No. 38492

AFTER FINAL – EXPEDITED PROCEDURE**RESPONSE TO OFFICE ACTION**

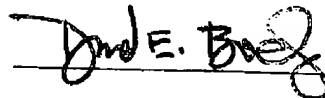
Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Applicant hereby responds to the Office Action of October 25, 2004. Kindly amend the application as follows.

AMENDMENTS TO THE CLAIMS begin on page 2 of this paper.

REMARKS/ARGUMENTS begin on page 34 of this paper.

I certify that on January 25, 2004 this correspondence, along with any documents referred to therein, is being transmitted by facsimile to Art Unit 2183 at FAX no. 703 872 9306 and deposited with the United States Postal Service as First Class Mail in an envelope with sufficient postage addressed to Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.



Response to Office Action
2727886.3

1

114596-03-4000 09/385,394

Application Serial No. 09/385,394
Atty. Docket No. 114596-03-4000

MPEP § 706.07 elaborates on § 1.113, as follows, emphasis added:

706.07 Final Rejection

Before final rejection is in order a clear issue should be developed between the examiner and applicant.

....

In making the final rejection, all outstanding grounds of rejection of record should be carefully reviewed, and any such grounds relied on in the final rejection should be reiterated. They must also be clearly developed to such an extent that applicant may readily judge the advisability of an appeal unless a single previous Office action contains a complete statement supporting the rejection.

However, where a single previous Office action contains a complete statement of a ground of rejection, the final rejection may refer to such a statement and also should include a rebuttal of any arguments raised in the applicant's reply.

Claim 104 was briefly mentioned in paragraphs 10 and 42 of the Office Action of February 2004 in the context of **Goetz '913 alone**. Because the Office Action of February 2004 made no element-by-element comparison of claim 104 to Goetz '913 or any other reference, no rejection was raised in February 2004.

Applicant's paper of July 2004 went well beyond the duty of an applicant – Applicant made a reasonable guess at what the Examiner's position might be, and fully responded by showing that certain language of claim 104 is not met by the single reference mentioned in the relevant portions of the February Office Action.

Paragraph 14.7 of the Office Action of October 2004 states that “one cannot show nonobviousness by attacking references individually.” The October Action is a *non sequitur* – only one reference was cited against claim 104 in February 2004, and obviousness of claim 104 was never suggested before October. Thus an attack against the single reference applied is totally proper. The failure of the October Office Action to “Answer All Material Traversed” is a breach of Patent Office procedures, and prevents final rejection.

Taken together, the two Office Actions raise confusion, not a rejection. It is totally impossible to discern the Examiner's position – is it based on Goetz '913 alone, or on some combination of references? Does the October Office Action purport to switch from § 102 to § 103? Does the Examiner believe that Goetz '913 teaches the claim limitation discussed in the July 2004 response (two memory regions that “[follow] first and second data storage conventions”), or not? If so, where? By failing to “Answer All Material Traversed,” MPEP

Application Serial No. 09/385,394
Atty. Docket No. 114596-03-4000

§ 707.07(f), does the October Office Action concede that the “instruction” of claim 104 is absent from the one reference relied upon?

Further, claim 104 recites two memory regions that are “necessarily disjoint.” Neither Office Action mentions this limitation. If the October Office Action raises any rejection of claim 104, then it is a “new ground of rejection not necessitated by amendment” which renders final rejection premature.

Without some “[clear statement] of reasons in support” of any rejection – a designation of a particular part of a particular reference, and a “clear explanation” of the “pertinence” of that portion, 37 C.F.R. § 1.104(c)(2) – the October Office Action fails to comply with the prerequisites for examination, let alone final rejection set forth in 37 C.F.R. § 1.113(b). Final rejection on unstated grounds exceeds the Examiner’s authority.

Further, MPEP § 706.07 makes clear that where neither a reference nor a particular part of a reference are designated, no “clear issue” is developed for appeal. It is impossible to appeal from a position that the examiner has not articulated – the Board simply refuses to entertain the appeal. *E.g., Ex parte Schricker*, 56 USPQ2d 1723, 1725 (Bd. Pat. App. & Interf. 2000) (“The examiner has left applicant and the board to guess as to the basis of the rejection and after having us guess would have us figure out (i.e., further guess) what part of which ... document supports the rejection. We are not good at guessing; hence, we decline to guess.”). Until a “clear issue” is developed, MPEP § 706.07 makes clear that final rejection is premature.

For each of these reasons, final rejection is premature.

II. No “Clear Issue” Is Developed for Claim 22 – Final Rejection is Therefore Premature

Claim 22 is discussed at paragraph 52 of the Office Action of the February 2004 and paragraph 14 of the October 2004 Office Action. Paragraph 52.4 of the February Action compares the “the indicator elements each having a value indicating the data storage convention under which instructions from the associated region are to be executed” to Goetz ’913, col. 17, lines 24-33 and to no other portion of any reference.

Application Serial No. 09/385,394
Atty. Docket No. 114596-03-4000

Applicant's paper of July 2004 fully responded to the February 2004 Action, by showing that this language is not met by the indicated portion of Goetz '913 (Response to Office Action of July 2004, at 34).

The October Office Action makes no "rebuttal" responsive to the July showing. The October Action makes no showing that the "indicator elements" of claim 22 are met by col. 17 or any other portion of Goetz '913. Nor does the October Action indicate any other portion of any other reference that might be thought to correspond. Instead, the October Office Action responds with a *non sequitur*, that the claim language might correspond to some unspecified portion of some unspecified reference.

For much the same reasons as stated above in connection with claim 104, there is no rejection of claim 22, let alone a final rejection – there is no coherent statement of any rejection that might be pending.

III. The Office Action of October 2004 Raises a New Ground of Rejection of Claim 87, an Unamended Claim

Since its original filing in 1999, claim 87 has recited "control-transfer instruction of a computer ... architecturally defined to transfer control directly to a destination instruction."

The discussion of claim 87 in the Office Action of February 2004 (see paragraph 100) was too brief to constitute a rejection. The February Action only suggested that there was some issue relating to unspecified portions of Goetz '913, Brender '422, and Murphy '947, combined in some unspecified way. The February Action was no more than an invitation to Applicant to attempt to guess at the ground of rejection – it was not itself a rejection. Therefore, if any rejection exists in the October Office Action, it is a new ground, not necessitated by amendment.

The Office Action of October 2004 now for the first time compares this language of claim 87 to a designated portion of a reference. The portion now relied upon was never cited in the previous Office Action. If the October Action is sufficient to raise a rejection at all, it does so by raising a new ground of rejection not necessitated by amendment.

For these reasons, the October Office Action is either insufficient to support final rejection of claim 87, or raises a new ground was not necessitated by any amendment. Under MPEP § 706.07(a), finality of the Action of October 2004 is premature.

Application Serial No. 09/385,394

Atty. Docket No. 114596-03-4000

IV. Examination of the Application as of October 2004 was Not Completed

A number of references submitted on the Form 1449 filed July 12, 2004, and returned with the Action of October 2004 are crossed off without consideration. Contrary to the statement in the Office Action, legible copies of all required references were made available in parent applications that were identified in the Information Disclosure Statement. The Information Disclosure Statement of July 2004 contained the following statement, pursuant to 37 C.F.R. § 1.98(d):

3. For non-patent items listed on the enclosed Form PTO-1449 for which a copy is not already made of record in this application, a copy was previously cited by or submitted to the Patent and Trademark Office in application Serial No. 09/239,194, filed January 28, 1999, Yates et al., Executing Programs for a First Computer Architecture on a Computer of a Second Architecture, in application Serial No. 09/322,443, filed May 28, 1999, Reese et al., Profiling of Computer Programs Executing in Virtual Memory Systems, or in application 09/626,325, filed July 26, 2000, Yates, et al., Computer with Two Operating Systems.

The IFW's of the parent applications identified in the IDS reveal that copies of the references refused consideration were indeed made of record in these parent applications on the dates, and with the number of pages, indicated:

	09/239,194	09/322,443
WO 99/08188 Kelly	5/6/03 101	
WO 99/08191 Kelly	5/6/03 88	
T.M. Conte, et al., "Accurate and practical profile-driven compilation using the profile buffer" (Dec. 1996)	4/21/03 10	11/26/99 12
T.M. Conte, et al., "Hardware based profiling: An effective technique for profile-driven optimization" (Feb. 1996)	4/21/03 39	11/26/99 39
T.M. Conte, et al., "Using branch handling hardware to support profile-driven optimization" (Dec. 1994)	4/21/03 11	11/26/99 11
J.S. Cox et al., "Commercializing profile-driven optimization." (Jan. 1995)	4/21/03 8	11/26/99 20*
Dean, ProfileMe: Hardware Support for Instruction-Level Profiling on Out-of-Order Processors," IEEE 1997, pp. 292-302	5/6/03 12	9/30/04 12
R.E. Hank, et al., Proceeding of the 28 th Annual International Symposium on Microarchitecture, pp. 158-168 (Dec. 1995)		11/26/99 20*
Intel Corporation, Intel Processor Family Developer's Manual (1997), pages 1-1 to 1-6, 2-1 to 2-20	4/21/03 43**	9/30/04 **
Intel Corporation, Intel Processor Family Developer's Manual (1997), vol. 3 (Architecture and Programming Manual), pages 3-1 to 3-3, 3-10 to 3-13, 12-1 to 12-27, 14-1 to 14-30		9/30/04 **